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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/625,228	07/24/2000	David Caplan	A-67467-2/RBC//MAK	6295

23910 7590 05/06/2003

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EXAMINER

TRAN, KHOA H

ART UNIT

PAPER NUMBER

3634

DATE MAILED: 05/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/625,228

Applicant(s)

CAPLAN ET AL.

Examiner

Khoa Tran

Art Unit

3634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-21,23,37-45,50 and 52-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-19,23,37-42,44,45,50,52 and 55-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 20,21,43,53 and 54 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 2/22/02 is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Continued Prosecution Application

The request filed on December 27, 2002 for a Request for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/625, 228 is acceptable and a RCE has been established. An action on the RCE follows.

Election/Restrictions

Applicant's election without traverse of Species I in Paper No. 14 is acknowledged. Accordingly, claims 20, 21, 43, 53 and 54 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species.

Drawings

The proposed drawings correction and/or the proposed substitute sheets of drawings, filed on December 27, 2002 have been approved.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 15, 17, 19, 37, 40, and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Deutsche Patent No. DE9313107. The claims are of such breadth that they read on the CD rack of Deutsche Patent No. DE9313107. Deutsche Patent No.

DE9313107 discloses a plurality of injection-moldable holders forming a continuous fan out loop by interlocking with the adjacent holders, the holder comprising a plurality of one unitary piece of holders, each holder having a first and second spaced-apart walls (10) that configure to form a slot therebetween to retain an object therein, see Figure 8a. The first holder having a base (24) that has a male engaging mechanism (21) of a slot opening that leads into a circular inwardly curved aperture and the second holder having an outwardly extended female engaging mechanism of a distal end (23) that is shaped to be able to pass through a slot on the first holder and to be retained therein the circular aperture of the first holder's engaging mechanism. See Figures 5, 6 and 7b.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18, 38, 39, 42, 44 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deutsche Patent No. DE9313107 as applied to claims 15, 17, 19, 37, 40, and 41 above, and further in view of Callahan et al. Callahan et al. teach a flexible spring projection with an L-shaped slot (19-1 and 19-2, see Figures 4A-B and 5A), formed on the first and second walls of the holder. It would have been obvious to one of ordinary skill in the art at the time of invention was made to provide the holder's sidewalls of Patent No. DE9313107 with the provision of flexible spring projections as

taught by Callahan et al. in order to have the springs to secure the object that is placed therein the holder. With respect to the holder that is formed from injection molded plastic, it should be noted that injection molding is notoriously old and well known per se in the industry of making a holder and plastic is a well-known material. Accordingly, it would have been no more than an obvious matter of engineering design choice to select the type of well-known material of plastic to produce the holder by a well-known process of injection molding base on the desire application thus producing no new matter and unexpected results because it is well within the level of skill of one of ordinary skill to utilize known features of the art for the purpose that they are known. With respect to claim 39, it would have been an obvious matter of engineering design choice as determined through routine experimentation and optimization for one of ordinary skill in the art to routinely dimension the spaced-apart first and second walls to be approximately 5 inches for a particular application thus producing no new matters.

Claims 23, 50, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deutsche Patent No. DE9313107 in view of Callahan et al. as applied to claims 15-19, 37-42, 44, and 45 above, and further in view of J. F. Dohrwardt. Dohrwardt teaches a plurality of holders connected together by the male and female coupling mechanisms. The first holder having a male coupling mechanism (17) extending from a base (14) and a through slot (16) located adjacent to the male coupling mechanism. The second holder having a female coupling (18) with an inner and outer surfaces and it is shaped to be received in the slot of the adjacent holder, wherein the male and the female couplings are interconnected with one another and to

be seated in a groove between adjacent teeth on a sprocket. See Figures 1-3. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the sprockets of the Deutsche Patent No. DE9313107 with the provision of toothed sprockets and to provide the holders with the provision of male and female coupling mechanisms as taught by Dohrwardt in order to have the toothed sprocket to rotate the connecting loop holders therebetween the teeth of the sprocket because it is well within the level of skill of one of ordinary skill to utilize known features of the art for the purpose for which they are known, thus the modification producing no unexpected results.

Claims 55-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deutsche Patent No. DE9313107 in view of Callahan et al. and J. F. Dohrwardt as applied to claims 15-19, 23, 37-42, 44, 45, 50, and 52 above, and further in view of H. C. Smith. Smith teaches a female hook engaging mechanism (27) having a round inner surface and a round outer surface. See Figures 3 and 6. It would have been an obvious matter of design choice to one of ordinary skill in the art to modify the female engaging mechanism of Dohrwardt with the provision of a hook engaging mechanism as taught by Smith in order to take play to connect and retain therein the slot of the male engaging mechanism, thus producing no new matter or unexpected results.

Response to Amendment

Applicants' arguments filed on December 27, 2002 have been considered but are have been fully considered but they are not deemed to be persuasive.

With respect to applicant's arguments that Deutsche Patent No. DE9313107 fail to teach "seated in a grove between adjacent teeth on a sprocket" is not commensurate with the scope of the claim in the 35 USC § 102 rejections. Further, Applicant should note that obviousness couldn't be established by attacking references individually when a rejection is based on a combination of references.

With respect to applicant's arguments on claim 37 that Deutsche Patent No. DE9313107 fail to teach the "inward and outward surface" on the holder, the examiner respectfully disagrees. It should be noted that no basis has been established to what is considered the inward and outward on the holder thus the claim is vague and the limitation set forth inherently read on the individual distal end of the holder of Deutsche Patent No. DE9313107. Note that one end of the holder has an inward surface prior forming a female mechanism and the opposite end of the holder has an outward projection prior forming a male mechanism.

With respect to applicant's arguments that Callahan and Dohrwardt is unsound because the proposed of the combination is based on impermissible hindsight because Callahan and Dohrwardt's apparatus could not be physically incorporated into that Deutsche Patent No. DE9313107 apparatus, it should be noted that a combination of references is proper for any reason taught by the prior art. There is no requirement that references be combined for the same reason as the applicant and there is no requirement for the bodily incorporation of references. In this case, the pertinence to the problem being solved has been indicated and taught by Callahan and Dohrwardt. It should be noted that any judgment on obviousness is in a sense necessarily a

reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khoa Tran whose telephone number is (703) 306-3437. The examiner can normally be reached on Monday through Thursday from 8:30 A.M. to 7:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola, can be reached on (703) 308-2686. The fax phone number for this Group is (703) 305-3597 or (703) 305-3598.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168.

If the applicant is submitted by facsimile transmission, applicant is hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and M.P.E.P. 502.02). In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check **should not be** submitting by facsimile transmission separately from the check. Responses submitted by facsimile transmission should include a Certificate

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of Transmission (M.P.E.P 512). The following is an example of the format the certification might take:

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Khoa Tran
April 07, 2003



Alvin Chin-Shue
Primary Examiner